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**JUL 19 2010**

**OFFICE OF PETITIONS**

CLARK & ELBING LLP  
101 FEDERAL STREET  
BOSTON MA 02110

In re Patent No. 7,582,296 : DECISION ON REQUEST  
Giles et al. : FOR  
Issue Date: September 1, 2009: RECONSIDERATION OF  
Application No. 10/523,444 : PATENT TERM ADJUSTMENT  
Filed: January 31, 2005 : and  
Atty Docket No. 50304/059001 : NOTICE OF INTENT TO ISSUE  
: CERTIFICATE OF CORRECTION

This is a decision on the petition filed on November 2, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by five hundred and forty-five (545) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by five hundred and thirty-one (531) days is **GRANTED to the extent indicated herein.**

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on February 1, 2008, and ends on October 5, 2008, the day before the RCE was filed, and is 248 (not 249) days. 'See 35 U.S.C. 154(b)(1)(B)(i). As such, the patent term adjustment is 779, not 780 days.

Patentees dispute the 13 day reduction to the patent term adjustment pursuant to 37 CFR 1.704(c)(10) for the filing of an Information Disclosure Statement on June 17, 2009.

In this instance, it is undisputed that patentees filed the IDS after the mailing of the notice of allowance. A review of the IDS filed on June 17, 2009, reveals that it did not include a

proper § 1.704(d) statement. Rather, it is noted that the Information Disclosure Statement includes a certification statement pursuant to 37 CFR 1.97(e)(1). Specifically, the certification statement states:

that the item of information in this is a statement is a communication from a foreign patent office in a counterpart foreign application, dated May 22, 2009, which is not more than three months prior to the filing of the information disclosure statement.

*Excerpt taken from Information Disclosure Statement, filed June 17, 2009, p. 1.*

However, the statement required under 37 CFR 1.704(d) must state that:

[E]ach item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

The statement accompanying the IDS filed June 17, 2009, does not contain the language required by 37 CFR 1.704(d). Accordingly, pursuant to 37 CFR 1.704(c)(10), it is concluded that the period of reduction of 13 days is merited and will remain.

The Office responded to the IDS on June 22, 2009. Thus, the period of adjustment was properly reduced by the lesser period of 13 days, beginning on the date the IDS was filed, June 17, 2009, and ending on the mailing date of the Office action or notice in response to the IDS, June 22, 2009. Accordingly, the period of reduction of 13 days will remain.

Patentees' argument as to the reduction of the patent term adjustment of 47 days has been considered and is persuasive. A review of the application reveals that a reduction of the patent term adjustment of 47 days was entered for the filing of a "Reply to Notice of Allowance and Notice of Allowability", on June 17, 2009, after the mailing of the Notice of Allowance and Issue Fee Due was mailed on May 19, 2009. Such a paper is not

identified as one of the papers<sup>1</sup> the filing of which the Director has specifically deemed not be a "failure to engage in reasonable efforts" within the meaning of 37 CFR 1.704(c)(10)<sup>2</sup>. However, it is obvious that the "Reply to Notice of Allowance and Notice of Allowability" is a transmittal letter to accompany the issue fee payment made on June 17, 2009. This paper does not constitute a "failure to engage in reasonable efforts" to conclude prosecution within the meaning of 37 CFR 1.704(c)(10).

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<sup>1</sup> It is noted that *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed*, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001) states, in pertinent part, that:

... the Office is publishing this notice to provide guidance in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10).

<sup>2</sup> 37 CFR 1.704(c)(10) provides that:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the periods of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the periods of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or other such paper; or

(ii) Four months...

Thus, reduction to patent term adjustment of 47 days pursuant to 37 CFR 1.704(c)(10) was not warranted and will be removed.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **five hundred thirty-one (531) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3222.



Kenya A. McLaughlin  
Petitions Attorney  
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

**CERTIFICATE OF CORRECTION**

PATENT : 7,582,296 B2

DATED : Sept. 1, 2009

INVENTOR(S) : Gilles et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[\*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (236) days

Delete the phrase “by 236 days” and insert – by 531 days--